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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of:

Jaime Navarrete

Group Art Unit: 1745

Serial No. 10/664,147

Examiner: T. M. Dove

Filed: September 17, 2003

For: THE USE OF GRASS LIGNINS IN THERMOPLASTICS

VIA FACSIMILE
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AMENDED REPLY BRIEF 37 CFR § 1.191 § 41.41

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This Amended Reply Brief is filed to amend the Reply to Examiner's Answer filed 01-12-2006, to put that Reply in proper form for appeal.

CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office on February 8, 2006.



Jan Davis

Applicants note that the Reply to Examiner's Answer should have been labeled reply brief. In addition the sections required of a reply brief under §41.37 which where filed on August 18, 2005 are include to put this Reply Brief in proper form. The Arguments filed in Applicant's Reply to Examiner's Answer of 01-12-2006 are unchanged. No fee is believed due, however, if the office determines that a credit is due, or an additional fee is necessary than they are authorized to charge deposit account 08-2447.

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I. REAL PARTY IN INTEREST

Daramic, Inc., is the real party in interest as the assignee of record in the instant application.

II. RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences.

III. STATUS OF THE CLAIMS

Claims 1-14 were filed in this case. Claims 10-14 drawn to a thermoplastic polymer were restricted out of this case by the Examiner. In the Amendment of March 17, 2005, claim 8 was cancelled. Claims 1-7 and 9 stand finally rejected under 35 U.S.C. 102(b) as being anticipated from Navarrette. Applicant amended claims 4 and 9 in an amendment after final filed on July 25, 2005. The Examiner withdrew the 35 U.S.C. 112, second paragraph to claims 21-26, in the advisory action of August 4, 2005. The Examiner has indicated that the amendment after final would be entered for appeal purposes. Claims 1-7 and 9, finally rejected under 35 U.S.C. 102(b) are the subject of this Appeal.

IV. STATUS OF AMENDMENTS

Claims 4 and 9 were amended after the Final Rejection based on a rejection to claims 4 & 9 under 35 U.S.C. 112, second paragraph. In the Examiner's Advisory Action before the Filing of an Appeal, of August 4, 2005, the Examiner indicated that the amendment to claims 4 and 9 was entered for appeal purposes and that the rejection to claims 4 and 9 under 35 U.S.C. 112, second paragraph has been removed.

V. SUMMARY OF THE CLAIMED SUBJECT MATTER

The following is a concise explanation of the subject matter defined in independent Claims 1 and 6.

According to Claim 1, the instant invention is a battery separator (specification page 4, line 20) which comprises: a microporous membrane including, an ultra high molecular weight polyethylene (specification page 4, line 21), a filler (specification page 4, line 21), and a grass lignin (specification page 4, line 5).

According to Claim 6, the instant invention is a battery separator (specification page 4, line 20) which is comprised of a microporous membrane (specification page 4, line 21) having an open cell structure (specification page

4, line 26) with pores sizes in the range of about 0.1 to about 1 micron (specification page 4, line 23) and porosity greater than 10% (specification page 4, line 23-24). The microporous membrane is comprised of about 15-25% by weight of an ultra high molecular weight polyethylene (specification page 5, line 2); about 50-80% by weight of a filler (specification page 5, line 2); and about 5-20% by weight of a grass lignin (specification page 5, line 3).

VI. GROUND'S OF REJECTION TO BE REVIEWED ON APPEAL

Claims 1-7 and 9, stand finally rejected under 35 U.S.C. §102(b) as being anticipated from Navarrete are the subject of this Appeal.

VII. ARGUMENT

Applicants note that in the Examiner's Answer the Examiner has acknowledged that: the (1) REAL PARTY IN INTEREST, (3) STATUS OF THE CLAIMS, (4) STATUS OF AMENDMENTS, (5) SUMMARY OF THE CLAIMED SUBJECT MATTER, (6) GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL, and (7) CLAIMS APPENDIX, are all correct. Further it is noted that Applicants provided a statement identifying (2) RELATED APPEALS AND INTERFERENCES.

Applicants note that there is no controversy on what the stated grounds of rejection are, the only issue in controversy is the Examiner's rejection of claims 1-7 and 9 as anticipated, under Section 102(b) over the Navarrete et al., WO 02/28955 A2.

There is no controversy that Navarrete et al., WO 02/28955 A2 mentions glass lignins in the background of the invention.

The only real question before the board is whether Navarrete et al., WO 02/28955 A2 teaches the use of grass lignins. Applicant an inventor, on the prior art reference claims that it does not.

Lignin as used repeatedly in the specification of Navarrete et al., WO 02/28955 A2 describe the lignin as a by product of wood pulping operations. See Navarrete et al., WO 02/28955 A2, page 1, line 13, page 6, lines 12-13. It should be clear to one of ordinary skill in the art that grass lignins which are obtained from rice, corn or sugar cane are not a product of wood pulping operations. In the body of the application, under the detailed description of the invention, the prior art clearly states that lignins are "by-products of wood pulping operations" and that "[l]ignins include softwood lignins, hardwood lignins and combinations thereof." See Navarrete et al., WO 02/28955 A2, page 6, lines 12-16.

A. Consideration of the Prior Art in its Entirety

The prior art is good for everything it teaches, not just the invention it describes or claims. See *EWP Corp. v. Reliance Universal, Inc.*, 755 F.2d 898, 907, 225 USPQ 20, 25 (Fed. Cir. 1985) ("A reference must be considered for everything it teaches by way of technology and is not limited to the particular invention it is describing and attempting to protect. On the issue of obviousness, the combined teachings of the prior art as a whole must be considered.")

By the same token, "[i]t is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art." *In re Wesslau*, 353 F.2d 238, 241, 147 USPQ 391, 393 (CCPA 1965); see also *Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc.*, 796 F.2d 443, 448-449, 230 USPQ 416, 420 (Fed. Cir. 1986) (holding that the district court, by failing to consider a prior art reference in its entirety, ignored portions of the reference that led away from obviousness). In the Navarrete et al., WO 02/28955 A2, reference, the Examiner is using a mention of the existence of grass lignins as a teaching, when it should be clear to anyone of ordinary skill

in the art that, the reference in the background only acknowledged their existence, and attempted to explain how they are different chemically from the softwood or hardwood lignins of the Navarrete et al., WO 02/28955 A2, invention.

The Question before the Board

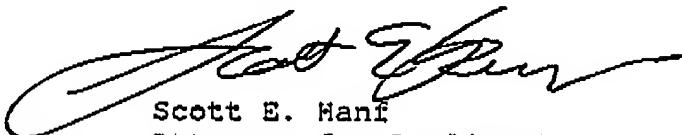
The only question before the Board is whether Navarrete et al., WO 02/28955 A2 teaches the use of grass lignins.

It should be unquestioned that Navarrete et al., WO 02/28955 A2, in the detailed description of the invention only teaches use of lignins as the by-products of wood pulping operations (page 6, lines 11, 12) and goes on to say that lignins include softwood lignins, hardwood lignins and mixtures thereof (page 6, lines 14 and 15). From this it should be clear that grass lignins, which do not come from wood pulping operations, are not taught.

Conclusion

In view of the foregoing, Appellants respectfully request that the rejection be overturned and that the instant application be allowed to proceed to issuance.

Respectfully submitted,



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ART UNIT 1745

VIII. CLAIMS APPENDIX

1. (previously presented) A battery separator comprising:

a microporous membrane including
an ultra high molecular weight polyethylene,
a filler, and
a grass lignin.

2. (original) The separator of claim 1 wherein said grass lignin comprises about 5-20% by weight of said membrane.

3. (original) The separator of claim 2 wherein said grass lignin comprises about 5-10% by weight of said membrane.

4. (previously presented) The separator of claim 1 wherein said grass lignin source being selected from the group consisting of: bagasse, straw, abaca, sisal, flax, jute, hemp, and combinations thereof.

5. (original) A lead acid battery including the separator of claim 1.

6. (previously presented) A battery separator comprises:
a microporous membrane having an open cell structure with
pores sizes in the range of about 0.1 to about 1 micron and
porosity greater than 10%, and where said microporous membrane
comprises:

about 15-25% by weight of an ultra high molecular weight
polyethylene;

about 50-80% by weight of a filler;

about 5-20% by weight of a grass lignin.

7. (original) The separator of claim 6 wherein said filler
being selected from the group consisting of precipitated silica,
oxide compounds, and mixtures thereof.

8. (cancelled) The separator of claim 6 wherein said oil
being selected from the group consisting of mineral oil, olefinic
oil, paraffinic oil, napthenic oil, aromatic oil, and mixtures
thereof.

9. (previously presented) The separator of claim 6 wherein
said grass lignin source being selected from the group consisting
of: bagasse, straw, abaca, sisal, flax, jute, hemp, and
combinations thereof.

10. (withdrawn) A thermoplastic polymer formulation comprising:

up to about 80% by weight of the formulation being thermoplastic polymer;

up to about 20% by weight of the formulation being a processing oil, and

up to about 10% by weight of the formulation being a grass lignin.

11. (withdrawn) The formulation of claim 10 wherein said polymer being a polyolefin.

12. (withdrawn) The formulation of claim 10 wherein said polymer being an ultrahigh molecular weight polyethylene.

13. (withdrawn) The formulation of claim 10 wherein said polymer includes a filler.

14. (withdrawn) The separator of claim 10 wherein said grass lignin being sourced from bagasse, straw, abaca, sisal, flax, jute, hemp, and combinations thereof.

IX. EVIDENCE APPENDIX

There is nothing in the Evidence Appendix.

X. RELATED PROCEEDINGS APPENDIX

Applicant is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be affected by or have a bearing on the Board's decision in the pending appeal.